

REMARKS

The above-listed claim amendments along with the following remarks are fully responsive to the Office Action set forth above. Claims 10 and 40 are amended. New claim 51 is added. Claims 1-6, 8-28, 30-37, and 40-51 are pending after entry of this Amendment.

The present invention includes methods for treating precursors comprising an imageable coating on a substrate, the methods including heat-treating the precursors in such a manner that the removal of moisture from the imageable coating is inhibited. An object of the invention is to provide precursors which are of consistent performance over their entire surface area; see specification at page 6, lines 24-25. Removal of moisture during heat-treatment is accomplished, for example, by wrapping the precursor in a water-impermeable sheet material (page 7, lines 17-21), or by heat-treating in a non-drying environment such as a humidity-controlled oven (page 7, lines 22-24).

Claims 10 and 40 are amended to recite that the respective methods may be applied to a stack of at least ten precursors. No new matter is introduced by the amendments. Support for the amendments can be found in Example 1 on page 30 of the specification, and Example 2 on page 31 of the specification, in which stacks of ten useable precursors were heat-treated according to the methods of the invention. As described in the specification, when precursors are treated in a stack, the stack is considered to include only the number of useful precursors and not the number of reject or dummy precursors; see page 12, lines 9-16.

Claim Rejections over McCullough

Claims 1-6, 8, 11, 13-19, 21, 41, 45 and 47 were rejected under 35 U.S.C. § 102(b) as anticipated by PCT published application WO 99/21715 of McCullough, *et al.* The Examiner asserts that McCullough reports a method of manufacturing a printing form precursor which comprises a positive-working coating on a substrate, including a heat treatment of the coated substrate to reduce the variation in sensitivity of the coating. The Examiner refers to Example 1 of McCullough, which reports a heat treatment for plate samples. In the reported heat treatment, individual plate samples were covered with interleaving and then wrapped in a specified polythene-coated paper. Plate samples were then placed in an oven with fan at 50° C for a period of time from 0 to 12 days.

The Examiner has taken the position that Example 1 of McCullough inherently teaches the present limitation of heat-treating the precursor under conditions which inhibit the removal of moisture from substantially the entire surface area of the imageable coating. A Declaration Under 37 C.F.R. § 1.132 from Kevin Barry Ray accompanies this Amendment. Dr. Ray is a co-inventor of the subject matter disclosed in McCullough (paragraph 4) and is familiar with the experiment described in Example 1 (paragraph 6). Facts provided by Dr. Ray in the declaration establish that the experiment described in Example 1 of McCullough was not performed under conditions which inhibited the removal of moisture from plate samples during heat treatment (paragraphs 7 and 8).

McCullough therefore does not disclose a method of heat-treating under conditions which inhibit the removal of moisture from substantially the entire surface area of the imageable coating. The present invention is distinguishable from the methods reported in McCullough. The present invention, unlike McCullough, provides methods including a step of heat-treating under conditions which inhibit the removal of moisture from the imageable coating. It is respectfully requested that the rejections over McCullough be withdrawn.

Claim Rejections over Yates

The Examiner has rejected claims 1-6, 8, 9, 11, 13-21, 41, and 45-47 under 35 U.S.C. § 102(e) as anticipated by Yates. The Examiner has also rejected claims 12 and 42 under 35 U.S.C. § 103(a) as obvious over Yates.

It is respectfully maintained by the Applicants that Yates is not available as a reference under 35 U.S.C. § 102(e). The present application claims priority under 35 U.S.C. § 119(e) to provisional application 60/146,920 filed August 3, 1999. The claim of priority was acknowledged by the Examiner in the Office Action Summary mailed February 5, 2003, at item 14.

U.S. Patent 6,391,524 to Yates, *et al.* was filed on November 19, 1999 with no priority claim to any earlier-filed application. Yates is therefore unavailable as a § 102(e) reference with respect to the present application, and the rejections are improper. Withdrawal of all rejections over Yates is requested.

Conclusion

All pending claims are now in condition for allowance. A notice to that effect is respectfully requested.

Respectfully Submitted,

MARTYN LOTT et al.

By: Sean Mahoney
Sean B. Mahoney, #51,984
FAEGRE & BENSON LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901
612/766-6845

Dated: May 5, 2003

M2:20541244.01

Serial No.: 09/587,813